



Attorney's Docket No. 10991471-13

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Steven W. Trovinger) Group Art Unit: 3651
Application No.: 10/698,504) Examiner: Patrick H. Mackey
Filed: October 30, 2003) Confirmation No.: 9590
For: METHOD AND APPARATUS FOR)
MAKING BOOKLETS)

**PETITION UNDER 37 C.F.R. § 1.78(a)(3) TO ACCEPT AN UNINTENTIONALLY
DELAYED REFERENCE UNDER 35 U.S.C. § 120 AND/OR § 365**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with 37 C.F.R. § 1.78(a)(3), Applicant hereby requests the U.S. Patent and Trademark Office to accept the unintentionally delayed reference to the claim under 35 U.S.C. § 120 and/or § 365 in this application.

In accordance with 37 C.F.R. § 1.78(a)(3)(i), the reference required by 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(2) is concurrently submitted in the accompanying Response to the Official Action dated April 30, 2004.

In accordance with 37 C.F.R. § 1.78(a)(3)(ii), a fee of \$1,330.00 is required under 37 C.F.R. § 1.17(t). The Director is hereby authorized to charge Deposit Account No. 08-2025 for the fee due.

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On information and belief, the entire delay between the date the reference to the claim under 35 U.S.C. § 120 and/or § 365 was due under 37 C.F.R. § 1.78(a)(2)(ii) and the date the reference required by 37 C.F.R. § 1.78(a)(2) is submitted in this application was unintentional. The following facts are presented in support of this Petition.

1. The present application is a divisional application of parent Application Serial No. 09/831,768. The parent Application Serial No. 09/831,768, was filed as a § 371 national stage application of International Application No. PCT/US99/23078, which is also a Continuation-in-Part Application of U.S. Application No., 09/162,844, filed on September 29, 1998.
2. The specification in parent Application Serial No. 09/831,768 did NOT contain a reference to the prior filed applications, because no such reference was required. The International Application was filed on September 29, 1999, and was therefore exempted per 37 C.F.R. 1.78(a)(2)(ii)(C) from the requirements of 37 C.F.R. §1.78 when the International Application was nationalized.
3. The present divisional application made a claim for priority to parent Application Serial No. 09/831,768, in the transmittal and to the International Application No. PCT/US99/23078 and to Continuation-in-Part Application No., 09/162,844, in the originally filed Declaration (see Attachment A). The present divisional application was filed on October 30, 2003, with a photocopy of the original specification of Application Serial No. 09/831,768.
4. Because the original specification of parent Application No. 09/831,768 did not contain a cross-reference to the International Application or CIP Application, the photocopy of the parent used to file the present divisional application did not contain a cross-reference to the International Application.
5. The present application was amended at the time of filing to include a cross-reference to Application Serial No. 09/831,768 (see Preliminary Amendment Attachment B). However, a cross-reference to the International Application and CIP Application was unintentionally not included in the Preliminary Amendment.
6. Upon becoming aware of the failure to timely meet the requirements of 37 C.F.R. §1.78, we promptly prepared and submitted this Petition to make the cross-reference to the International Application and CIP Application on page 1 of the specification in the present divisional application.

Accordingly, because all requirements for a proper Petition Under 37 C.F.R. §1.78 have been satisfied, granting of this Petition to recognize Applicant's claim for priority to the International Application is requested.

Date: July 16, 2004



Patrick C. Keane

Attorney's Docket No. 10991471-13

Application No. 10/698,504

Attachment A



ATTACHMENT A TO PETITION FILED JULY 16, 2004

DECLARATION AND POWER OF ATTORNEY
FOR PATENT APPLICATION

JUL 16 2004

ATTORNEY DOCKET NO. 10991471-1

As a below named inventor, I hereby declare that:

My residence/post office address and citizenship are as stated below next to my name;

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

Method And Apparatus For Making Booklets

the specification of which is attached hereto unless the following box is checked:

(X) was filed on Sep 29, 1999 as US Application Serial No. or PCT International Application Number US99/23078 and was amended on _____ (if applicable).

I hereby state that I have reviewed and understood the contents of the above-identified specification, including the claims, as amended by any amendment(s) referred to above. I acknowledge the duty to disclose all information which is material to patentability as defined in 37 CFR 1.56.

Foreign Application(s) and/or Claim of Foreign Priority

I hereby claim foreign priority benefits under Title 35, United States Code Section 119 of any foreign application(s) for patent or inventor(s) certificate listed below and have also identified below any foreign application for patent or inventor(s) certificate having a filing date before that of the application on which priority is claimed:

COUNTRY	APPLICATION NUMBER	DATE FILED	PRIORITY CLAIMED UNDER 35 U.S.C. 119
PCT	PCT/US99/23078	09/29/99	YES: <input checked="" type="checkbox"/> NO: _____ YES: _____ NO: _____

Provisional Application

I hereby claim the benefit under Title 35, United States Code Section 119(a) of any United States provisional application(s) listed below:

APPLICATION SERIAL NUMBER	FILING DATE

U. S. Priority Claim

I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code Section 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, Section 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

APPLICATION SERIAL NUMBER	FILING DATE	STATUS (patented/pending/abandoned)
09/162844	09/29/1998	Pending

POWER OF ATTORNEY:

As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith:

Customer Number 022879Place Customer
Number Bar Code
Label hereSend Correspondence to:
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80528-9599

Direct Telephone Calls To:

Edward Maker II
(650) 857-5143

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of Inventor: Steven W Trovinger Citizenship: USResidence: 1099 Parma Way Los Altos, CA 94204Post Office Address: 1501 Page Mill Road Palo Alto, CA 94304St. W. T.
Inventor's Signature

Date

11/23/99

**DECLARATION AND POWER OF ATTORNEY
FOR PATENT APPLICATION (continued)**

ATTORNEY DOCKET NO. 10991471-1

Full Name of # 2 Joint Inventor: Ross R Allen Citizenship: US
Residence: 408 Mainline Dr Belmont CA 94002
Post Office Address: 1501 Page Mill Road Palo Alto, CA 94304
Inventor's Signature: 
Date: 12/3/99

Full Name of # 3 Joint Inventor: Erik G Vaaler Citizenship: US
Residence: 707 Leahy Street # 216-B Redwood City, CA 94061
Post Office Address: 1501 Page Mill Road Palo Alto, CA 94304
Inventor's Signature: 
Date: 11/24/99

Full Name of # 4 Joint Inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature _____ Date: _____

Full Name of # 5 Joint Inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature _____ Date: _____

Full Name of # 6 Joint Inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature _____ Date: _____

Full Name of # 7 Joint Inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature _____ Date: _____

Full Name of # 8 Joint Inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature _____ Date: _____

Attorney's Docket No. 10991471-13

Application No. 10/698,504

Attachment B



ATTACHMENT B TO PETITION FILED JULY 16, 2004

PRELIMINARY AMENDMENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): **Steven W. Trovinger**
Serial No.: **09/831,768**

Group Art Unit: not available
Examiner: not available

Filed: **May 14, 2001**

Title: **Method and Apparatus for Making Booklets**

Atty Docket: **10991471-9**

PRELIMINARY AMENDMENT

Hon. Commissioner for Patents
Washington, D.C. 20231

Sir:

Please consider the following preliminary amendment in connection with the divisional application of the above-noted application filed herewith.

Amendments to the Specification begin on page 2 of this paper.

Amendments to the Claims are reflected in the listing of claims which begins on page 3 of this paper.

Remarks/Arguments begin on page 4 of this paper.

PRELIMINARY AMENDMENT

Amendments to the Specification

Page 1 of the application, after the Title please insert the following paragraph:

CROSS-REFERENCES TO RELATED APPLICATIONS

This application is a divisional of prior Application No. 09/831,768 filed May 14, 2001.

Amendments to the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the present application:

Listing of Claims:

Claims 1-39 (cancelled)

Claim 40 (currently amended) ~~The method of claim 37 including the step of Method for stacking sheets of printing media, comprising the steps of:~~

- a) ~~collecting the sheets in a stack on a workpiece, sheet-by-sheet, said sheets each having a fold therein;~~
- b) ~~registering the sheets on the workpiece, sheet-by-sheet, with the fold in each sheet and punching a hole in the sheets, sheet-by-sheet;~~
- c) ~~unloading the stack of collected and registered sheets from the workpiece.~~

Claim 41 (currently amended) ~~The method of claim 37 including the step of Method for stacking sheets of printing media, comprising the steps of:~~

- a) ~~collecting the sheets in a stack on a workpiece, sheet-by-sheet, said sheets each having a fold therein;~~
- b) ~~registering the sheets on the workpiece, sheet-by-sheet, with the fold in each sheet and cutting out a notch in selected sheets, sheet-by-sheet;~~
- c) ~~unloading the stack of collected and registered sheets from the workpiece.~~

Claims 42-62 (cancelled)

PRELIMINARY AMENDMENT

REMARKS

Applicant respectfully requests consideration of the above preliminary amendment.

Amendments to the Specification

The present application is a divisional of an original parent application. A section entitled "CROSS-REFERENCES TO RELATED APPLICATIONS" has been added after the title indicating that the present application is a divisional of prior Application No. 09/831,768 filed May 14, 2001.

Amendments

Claims 1-39 and 42-62 are cancelled and Claims 40 and 41 are remaining.

Respectfully submitted,

Steven W. Trovinger

By Susan E. Heminger
Susan E. Heminger
Reg. No. 36,449

October 27, 2003
Hewlett-Packard Company
Legal Department IPA
P.O. Box 272400
Fort Collins, CO 80527-2400